

### Remarks

The Office Action mailed December 23, 2003 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-12 are cancelled. Claims 13-48 are pending. Claims 13-21 are rejected. Claims 22-48 are newly added.

In accordance with 37 C.F.R. 1.136(a), a three month extension of time is submitted herewith to extend the due date of the response to the Office Action dated December 23, 2003, for the above-identified patent application from March 23, 2004, through and including June 23, 2004. In accordance with 37 C.F.R. 1.17, authorization to charge a deposit account to cover this extension of time request also is submitted herewith. A fee calculation sheet for newly added claims 22-48 along with authorization to charge a deposit account in the amount of the calculated fee are submitted herewith.

The objection to the specification is respectfully traversed. Specifically, an abstract has been submitted herein. Moreover, attached are copies of Figures 1-3 as originally submitted. No new matter has been added. Accordingly, Applicants request the objection to the specification be withdrawn.

The rejection of Claims 13, 15, 16 and 21 under 35 U.S.C. 102(e) as being anticipated by Luo (US Patent 5,909,491) is respectfully traversed.

Luo describes a method for sending a secure message  $M$  in a telecommunications system using public encryption keys and double encryption pairs. A sending transceiver (herein referred to as  $X$ ) sends an encrypted message  $E_x(M)$  of  $M$  to a receiving transceiver (herein referred to as  $Y$ ).  $Y$  encrypts the received encrypted message again as  $E_y(E_x(M))$  and sends it back to transceiver  $X$ . Transceiver  $X$  initially sends the message  $M$  encrypted as  $E_x(M)$  such that message  $M$  is no longer readable without a key, thus making it unreadable to those for whom the message is not intended. Encrypting of  $E_x(M)$  is done via a public key for transceiver  $X$ .

Transceiver Y encrypts the received encrypted message from transceiver X using the public key for the ultimate destination or intended receiver (herein referred to as T) for the message M. Once transceiver X receives the doubly encrypted message  $E_y(E_x(M))$  from transceiver Y, transceiver X can remove its own encryption using its secret key, thus obtaining encrypted message  $E_y(M)$ , which transceiver X then sends back to transceiver Y. Translating this process, transceiver Y receives an encryption of message M, namely  $E_y(M)$ , which can be then forwarded to T. T can then use its own secret key to decrypt the message and obtain the original message M. Accordingly, a message sent from transceiver X to transceiver Y, and ultimately to an intended receiver T is an encrypted form so that it is unreadable to those for whom the message is not intended.

Claim 13 recites a method for a digital signing of a message which is transmitted via a communication network to a signing unit, wherein the method comprises “signing the message to be signed via the mobile radio telephone ... thereby forming a signed message ... the signed message signifying a user’s intent to deliver the signed message and its content ....”

Luo does not describe nor suggest a method for digital signing of a message. Claim 13 describes a digital signing of a message to be signed as compared to the Luo description of a double encryption process to encrypt and make a message M unreadable while being transported to the intended receiver. Digital signing signifies a user’s intent to deliver a signed message according to Claim 13 and Luo describes encryption of a message M with no mention of a user’s intent. Claim 13 makes no mention of use of public keys and Luo describes the use of public keys to perform double encryption of a message. For at least the reasons set forth above, Claim 13 is submitted to be patentable over Luo.

Claims 15, 16 and 21 depend from independent Claim 13. When the recitations of Claims 15, 16 and 21 are considered in combination with the recitations of Claim 13, Applicants submit that dependent Claims 15, 16 and 21 likewise are patentable over Luo.

For the reasons set forth above, Applicants respectfully request that the Section 102(e) rejection of Claims 13, 15, 16 and 21 be withdrawn.

The rejection of Claim 14 under 35 U.S.C. § 103(a) as being obvious over Luo (US Patent 5,909,491) in view of Brown, IEEE Personal Communications, August 1995, is respectfully traversed.

Luo is described above.

Brown describes a public key encryption method used by a “certification authority (CA)” to provide a “certificate” to the mobile phone and the access controller (AC) of the service provider’s mobile network so as to allow the mobile phone to authenticate itself with the serving or visited mobile network. Specifically, the method described in Brown enables a roaming mobile phone to be authenticated during its registration with a visited serving network (visited location register or VLR) without the home serving network for the mobile (home location register or HLR) having to provide security information in the form of “triplets” or “SSD” information to the VLR for mobile authentication.

Claim 14 depends from Claim 13 which recites a method for a digital signing of a message which is transmitted via a communication network to a signing unit, wherein the method comprises “signing the message to be signed via the mobile radio telephone ... thereby forming a signed message ... the signed message signifying a user’s intent to deliver the signed message and its content ....”

No combination of Luo and Brown describes or suggests the recitations set forth in Claim 13, including signing the message to be signed via the mobile radio telephone, whereby signing indicates the mobile radio telephone user’s intent to deliver the signed message.

Moreover, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Luo nor Brown, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to combine Luo with Brown, because there is no motivation to combine the references suggested in

the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Luo is cited for teaching a double encryption method for transport of a message in an encrypted form from transmitter to receiver to intended addressee, and Brown is merely cited for teaching the use of a public key process for generating "certificates" to be used between the roaming mobile and the visited serving mobile network. However, since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn. Accordingly, for at least the reasons set forth above, Claim 13 is submitted to be patentable over Luo in view of Brown.

Claim 14 depends from independent Claim 13. When the recitations of Claim 14 are considered in combination with the recitations of Claim 13, Applicants submit that dependent Claim 14 likewise is patentable over Luo in view of Brown.

For at least the reasons set forth above, Applicants respectfully request the section 103 rejection of Claim 14 be withdrawn.

The rejection of Claims 17-20 under 35 U.S.C. § 103(a) as being obvious over Luo (US Patent 5,909,491) in view of Brown, IEEE Personal Communications, August 1995, and further in view of Kawan (US Patent 5,796,832) is respectfully traversed.

Luo and Brown are described above.

Kawan describes a financial transaction system in his Figure 1 which provides the functionality of an ATM network to wireless portable terminals. A host financial computer system 10 in Figure 1 is connected to a communications interface 12 that is coupled to a wireless communications interface 20 (or as is exemplified by a wireless communications interface 50 within Figure 2A). The wireless communications interface 50 in Figure 2A is connected to a terminal (e.g. terminals A, B, C, or D of Figure 2A) that transmits and receives data, wherein the terminal is connected to a smart card reader (e.g. smart card reader 64a in Figure 2B). In Figure 5 the smart card reader 210 is coupled to a smart card device 200 that encrypts data which is exchanged with the host financial system 10.

Claims 17-20 depend either directly or indirectly from dependent Claim 14. Claim 14 recites that "a public-key process is used for signing...." No combination of Luo in view of Brown and further in view of Kawan describes or suggests the recitations of Claim 14. Accordingly, for at least the reasons set forth above, Claim 14 is submitted to be patentable over Luo in view of Brown in view of Kawan.

Claims 17-20 depend either directly or indirectly from dependent Claim 14. When the recitations of Claims 17-20 are considered in combination with the recitations of Claim 14,

Applicants submit that dependent Claims 17-20 likewise are patentable over Luo in view of Brown, and further in view of Kawan.

For at least the reasons set forth above, Applicants respectfully request the section 103 rejection of Claims 17-20 be withdrawn.

With respect to newly added Claims 22-32, independent Claim 22 recites "a method for digitally signing ... by means of a signing apparatus ... a message to be transmitted to a receiving device ... characterized ... this message is then signed in the signing apparatus and transmitted back to the receiving device as a signed message."

None of the cited art describes or suggests such a method, and therefore, Applicants submit that independent Claim 22 is patentable over the cited art.

Claims 23-32 depend either directly or indirectly from independent Claim 22. When the recitations of Claims 23-32 are considered in combination with the recitations of Claim 22, Applicants submit that dependent Claims 23-32 likewise are patentable over the cited art.

With respect to newly added Claim 33, independent Claim 33 recites "a chip card for a mobile telephone ... wherein the chip card incorporates a signing device which has a memory unit for storing a private key necessary for producing a signed message ... characterized in that the signing device generates the signed message from a message to be signed which is received by the mobile telephone via a telephone network."

None of the cited art describe nor suggest such a chip card with a signing device as is recited in Claim 33. Therefore, Applicants submit that Claim 33 is patentable over the cited art.

With respect to newly added Claims 34-38, independent Claim 34 recites a method for transport via a communication network of a message to a mobile phone and transport of a corresponding signed message, wherein the method comprises "transmitting from a transmitter a message to be signed to a receiver ... transmitting ...to a mobile radio telephone whereat the

message to be signed may be signed ... and when signed ... generates a corresponding signed message ... transmitting the corresponding signed message ...."

None of the cited art describes or suggests the method of Claim 34, and therefore, Applicants submit that independent Claim 34 is patentable over the cited art.

Claims 35-38 depend from independent Claim 34. When the recitations of Claims 35-38 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 35-38 likewise are patentable over the cited art.

With respect to newly added Claims 39-40, independent Claim 39 recites a method comprising "a mobile radio telephone user receiving a message from a telephone network ... the user using the mobile radio telephone to generate a signed message corresponding to the received message ... and the user initiating transmission of the signed message ...."

None of the cited art describes or suggests the method of Claim 39, and therefore, Applicants submit that independent Claim 39 is patentable over the cited art.

Claims 40 depends from independent Claim 39. When the recitations of Claim 40 are considered in combination with the recitations of Claim 39, Applicants submit that dependent Claim 40 likewise is patentable over the cited art.

With respect to newly added Claims 41-45, independent Claim 41 recites a method for a wireless device wherein the method comprises "receiving a message ... displaying at least a portion of the message ... accepting input from the user indicating the received message is to be signed ... generating a corresponding signed message ... and transmitting the signed message."

None of the cited art describes or suggests the method of Claim 41, and therefore, Applicants submit that independent Claim 41 is patentable over the cited art.

Claims 42-45 depend either directly or indirectly from independent Claim 41. When the recitations of Claims 42-45 are considered in combination with the recitations of Claim 41, Applicants submit that dependent Claims 42-45 likewise are patentable over the cited art.

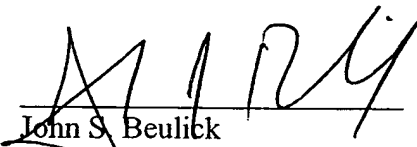
With respect to newly added Claims 46-48, independent Claim 46 recites a wireless device for receiving a message to be signed and transmitting a corresponding signed message, wherein the device comprises "an antenna for receiving and transmitting messages ... a display for displaying a received message ... input apparatus for accepting input from a user indicating the received message is to be signed ... and memory for storing an algorithm for generating a corresponding signed message."

None of the cited art describes or suggests the device of Claim 46, and therefore, Applicants submit that independent Claim 46 is patentable over the cited art.

Claims 47-48 depend from independent Claim 46. When the recitations of Claims 47-48 are considered in combination with the recitations of Claim 46, Applicants submit that dependent Claims 47-48 likewise are patentable over the cited art.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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